

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of:

Art Unit 2132

Rhoads et al.

Confirmation No. 8366

Application No.: 10/656,930

Filed: September 4, 2003

VIA ELECTRONIC FILING

For: DIGITAL AUTHENTICATION WITH  
DIGITAL ANALOG DOCUMENTS

Examiner: V. Perungavoor

Date: October 20, 2008

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

Appellants request review of the final rejection in the above-identified application. No amendment is being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reasons stated on the attached sheets. (No more than 5 pages are provided.)

Date: October 20, 2008

Respectfully submitted,

DIGIMARC CORPORATION

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**REASONS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW****Introduction:**

On appeal the rejection of claims 1, 3-12 and 14-21 will be reversed. Some of the reasons for reversal are discussed below.

**Art-Based Rejections:**

Claims 1, 3-8, 10-12, 14, 15 and 17-21 stand rejected as being anticipated by EP0650146 ("Kodak") in view of U.S. Patent No. 5,613,004 ("Cooperman"). Claim 9 stands rejected under Kodak, in view of Cooperman and in further view of U.S. Patent No. 5,467,447 ("Vogel"). Claim 16 stands rejected under Kodak, in view of U.S. patent No. 5,475,205 ("Behm").

*Claim 17*

Claim 17 recites – in combination with other features – an analog form converter analyzing a digital representation *to determine whether a verification system can check the authenticity of the digital representation before sending the digital representation.*

The final Office Action cites Kodak at Col. 4, lines 20-24, to meet these features. See the final Office Action, page 2, lines, 13-16. We disagree.

The cited passage deals with comparing two sets of data to determine whether a match exists, but says nothing of determining whether a verification system *can check* the authenticity of a digital representation *before sending* the digital representation. The cited Kodak passage is reproduced below:

*g) comparing the encoded portion of the digital data with encoded authorized user data to determine if a match exists; and h) sending a validation signal indication the existence of a match.*

The above cited Kodak passage assumes that the verification system can do the data match, and must have already sent a digital representation, but it says nothing of determining whether a verification system can check the authenticity of a digital representation before sending the digital representation.

Claim 17 stands ready for allowance since Kodak does not have the features it is relied upon for. Indeed, the final Office Action fails to establish a *prima facie* case of obviousness for claim 17.

#### *Claim 11*

Claim 11 recites that the embedded first authentication information is a *cryptographic hash* embedded as a watermark in a graphic on or in the analog form.

The final Office Action cites Kodak at Col. 1, lines 30-36 (“signature”) to meet these features. See the final Office Action, page 2, lines, 10-12. We disagree.

The cited passage deals with visual verification clues. The cited Kodak passage is reproduced below:

*Visual verification of identity plays a role in many types of transactions and security procedures. For example, signatures, fingerprints or images of faces are compared in to establish identity. The creation of a fraudulent identities or the misrepresentation of identity results can allow individuals to commit fraud and breach security systems. (emphasis added).*

The terms “signatures,” “fingerprints” and “images of faces” are examples of the visual verification tools in the cited Kodak passage. Thus, in this visual context, one of ordinary skill in the art would interpret a signature or fingerprint as a handwritten signature and an image of a human fingerprint.

This interpretation is supported at Kodak, Col. 5, lines 30-34. There, Kodak suggests that a fingerprint, signature or individual’s appears can be provided for display on display 70. Such a handwritten signature or human fingerprint is different than a cryptographic hash or digital signature.

The final Office Action fails to establish a *prima facie* case of obviousness for claim 11 since Kodak does not have the features it is cited for.

#### *Claim 20*

Claim 20 recites – in combination with other features – routing a signal to a remote system or device based at least in part on the reference code. Kodak is not understood to render obvious making routing decisions based on a reference code (or on, e.g., a validation requestor identification code).

The final Office Action cites Kodak at Col. 5, lines 17-21 to meet these features. See the final Office Action, page 2, lines, 17-19. We disagree. That Kodak passage (reproduced below) indicates that data storage can be located in different places for different embodiments, and that a card can include a photograph of the card holder.

*The location of data storage distinguishes different embodiments of the invention. In a first embodiment of the invention the image data is stored in readable digital form only on a card 10 itself. Thus, each card has image information unique to the card holder.*

Indeed, we interpret the phrase: “each card has image information unique to the card holder,” such that each card has a photograph of the cardholder. And the phrase: “[t]he location of data storage distinguishes different embodiments of the invention,” says nothing of using reference data to make routing decisions. In fact, it appears that Kodak would transmit a validation requestor identification number based on a request by a validation requestor. See Kodak, Col. 5, lines 48-52.

Thus, the cited Kodak passage fails to render obvious routing a signal to a remote system or device based at least in part on the reference code, in combination with other elements of claim 20. Claim 20 stands ready for allowance.

#### *Claim 10*

Claim 10 recites that there is a plurality of the apparatuses in the network; and a given one of the apparatuses uses the *reference code* to route the received digital representation and the reference code to another one of the apparatuses.

Here, for claim 10, the reference code is used to route the digital representation and the reference code to another of the apparatuses.

Recall that in the context of claim 10 (and base claim 1) the reference code is also used to obtain authentication information from a storage system.

The final Office Action does not address these features on page 2, lines 6-9. There, the final Office Action lumps claim 10 with claims 1, 3, and 14 as having the reference code separately sent. While separately sending a reference code is pertinent to, e.g., claim 1, it does not address the features of claim 10.

Claim 10 is again referenced in the final Office Action on page 4, last two lines, citing Kodak at Col. 6, lines 23-39. But Kodak, at the cited col. 6 passage, says nothing to render obvious a *reference code* used to route a received digital representation and the reference code to another one of the apparatuses. Indeed, Kodak does not use a reference code to route a received digital representation and the reference code to one of a plurality of apparatus.

Claim 10 stands ready for allowance.

#### *Claim 1*

Claim 1 recites – in combination with other features – a processor which receives a digital representation and a reference code associated therewith. *The reference code is included in the digital representation.* The processor includes an authentication information reader, and the processor: i) employs the reference code to retrieve the second authentication information associated therewith from the storage system.

Kodak does not show that a reference code, which is employed to retrieve second authentication information from a storage system, is included in a digital representation. Rather, it appears that the validation requestor identification code is merely sent to a validation requestor. This appears to be separate from any digital representation. See, e.g., Col. 3, lines 16-26.

Kodak at Col. 5, lines 34-58 calculates a pre-approval code from image data, but uses the validation requestor identification code to know which algorithm to use for the calculations. It is this requestor identification code that is separately sent, and not included in a digital representation.

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” KSR Int’l Co. v. Teleflex Inc., 127 S.Ct. 1727, 1734 (2007).

Here, for claim 1, the differences between the claimed invention and Kodak (and Cooperman) are too great.

Indeed, Kodak *teaches away* from embedding such a code in an image, by separately providing the code and image. We submit that one of ordinary skill would not even consult Cooperman’s embedding since Kodak teaches a separate transmission of the image and the code. Altering Kodak to accommodate Cooperman embedding still does not address the separate transmission.

We respectfully submit that Kodak and Cooperman are misapplied to claim 1.

Claim 1 stands ready for allowance.

*Claim 3, 12 and 14, and remaining claims*

Claims 3, 12 and 14 should be allowed for at least some reasons that are analogous to some of those noted above with respect to claim 1.

We reserve our right to present arguments on appeal, if needed, for the remaining claims as well.

**Conclusion:**

We respectfully ask that prosecution be reopened and a Notice of Allowance issued. Nevertheless, we stand ready to present these and additional arguments on appeal, if needed.

Date: October 20, 2008

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